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REMARKS

An information disclosure statement was filed on 7/20/2005. The examiner failed to return the Form PTO 1449 with the last office action with the references initialed as being considered by the examiner. The examiner is requested to return the Form PTO 1449 with the next office action with the references initialed as being considered by the examiner.

In regard to the examiner's objection to the specification, the specification has been amended above to overcome the objection. No new matter has been added.

In regard to section 2 of the office action, the examiner is requested to reconsider his objection to the drawings. There is sufficient text legends and reference characters with lead lines to satisfy the requirements of 37 C.F.R. In addition, MPEP 608.02(e) merely states:

"The examiner should see to it that the figures are correctly described in the brief description of the several views of the drawing section of the specification, that the reference characters are properly applied, that no single reference character is used for two different parts or for a given part and a modification of such part, and that there are no superfluous illustrations."

and then gives examples of form paragraphs. The drawings do not violate MPEP 608.02(e).

In regard to section 3 of the office action, the examiner is requested to reconsider his objection to the drawings. It

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should be noted that MPEP 2163.02 clearly states that "The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." And 37 C.F.R. 1.83(a) merely states:

"The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings."

In the present case, all of the features recited in the claims are shown in the drawings. For example, "communication operator" can be the wireless operator 12. Block 68 in Fig. 3 clearly shows selecting a download technology. As another example, the DAL 24 is clearly described as a system for selecting one of the download technologies. The examiner is respectfully requested to consult with his supervisor regarding the true requirements of 37 C.F.R. 1.83(a). There is no need to amend the current drawings.

In regard to paragraphs 4-5, the examiner is requested to reconsider his rejection under 35 U.S.C. 112, second paragraph. Contrary to what the examiner has stated, there is

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no single phrase in claims 1, 5, 6-9, 11, 13, 15-17, 19-20, 23-28 "download technology capability or download capability, content format capability". It appears that the examiner is under the misconception that describing an apparatus or method in terms of a capability is automatically indefinite. This is incorrect. The examiner is direct to MPEP 2173.05(g) which states:

"A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step."

Thus, there is nothing wrong with defining some part of the invention in functional terms.

Claims 1 has the phrase "a download technology capability of the remote device". This claim language is neither vague nor indefinite, and would be understood by a person skilled in the

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art after reading the patent application. For example, paragraph 0022 clearly describes:

"The download agents 30 comprise various download technologies which the operator supports, such as Binary Runtime Environment For Wireless (BREW), Java, Enhanced Message Service (EMS), Multimedia Message Service (MMS), Short Message Service (SMS), for example, or any other suitable download technology. The delivery abstraction module 26 is adapted to communicate with the download agents 30."

Paragraph 0030 clearly describes:

"The delivery abstraction layer 24 can then decide the most appropriate download technology as indicated by block 68. The download technologies can include different selections of mode technology support (such as GSM, CDMA, TDMA, etc.), and/or download capability support (such as BREW, Java, MMS, EMS, SMS, etc.), and/or content format support (such as MIDI, JPG, GIF, etc), etc. . This decision is preferably based on the details of the handset download capability provided by the toolkit application 22 to the delivery abstraction layer 24 and/or other parameters."

There is nothing vague or indefinite about the language "a download technology capability of the remote device". Likewise, there is nothing vague or indefinite about the terms "download capability" and "content format capability".

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In regard to claim 25 and the "means" language, such language is allowed in accordance with 35 U.S.C. 112, 6th paragraph:

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

There is nothing vague or indefinite about "means" language in the claims language, and this is explicitly authorized by 35 U.S.C. 112, 6th paragraph.

In regard to section 7 of the office action and claim 28, a memory 28 is clearly shown in the drawings. The examiner is directed to MPEP 2106.01 and MPEP 2164.06(c).

In regard to sections 8 and 9 of the office action and the language "adapted to", there is nothing vague or indefinite. The examiner is directed to MPEP 2111.04 "Adapted to," "Adapted for," "Wherein," and "Whereby" Clauses [R-3].

"Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;

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(B) "wherein" clauses; and

(C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In Hoffer v. Microsoft Corp., 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." Id. However, the court noted (quoting Minton v. Nat'l Ass'n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "'whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.'" Id.<"

The MPEP clearly indicates that "adapted to" language is acceptable language for a claim and should be given patentable weight. The examiner is requested to reconsider his rejections under 35 U.S.C. 112, second paragraph.

Claims 1-2, 13-14 and 27-28 were rejected under 35 U.S.C. 102(b) as being anticipated by Citrano et al. (WO 02/39596 A2). Claims 3-11, 16-17 and 19-24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Citrano et al. (WO 02/39596 A2) in view of Copinger et al. (US 2001/0046862 A1). Claims 12 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Citrano et al. (WO 02/39596 A2) in view of Chandhok et al. (US 2004/0267646 A1). Claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over Citrano et

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al. (WO 02/39596 A2) in view of Warwick et al. (US 2005/0055572 A1). The examiner is requested to reconsider these rejections.

Claim 1 claims providing a communications operator with a plurality of different download technologies. As noted in the specification, download technologies can include Binary Runtime Environment For Wireless (BREW), Java, Enhanced Message Service (EMS), Multimedia Message Service (MMS), Short Message Service (SMS), for example. A person skilled in the art understands the differences between these download technologies. Information sent in a BREW download technology format could not be read on a device having only SMS download technology capability for example.

Citrano et al. does not disclose different download technologies. "Multimedia capabilities" noted on page 2 of Citrano et al. relates to the capabilities of the client to play multimedia, not to the download capabilities of the client.

The examiner is directed to MPEP 2131. Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference (emphasis added). In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Anticipation requires identity of the claimed invention (emphasis added). Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985). For anticipation, there must be no difference between the claimed invention and the reference disclosure (emphasis added). Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). The corollary of

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the rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

In the present case, the examiner has not proven that there is identity between the cited references and the features of claim 1. In the present case, the examiner has not proven that each and every element of the claimed invention is disclosed in the cited references. In the present case, the examiner has not proven that there are no differences between the claimed invention and the reference disclosures. Thus, the cited reference does not "anticipate" the features of claim 1.

Citrano et al. does not disclose or suggest transmitting data from a remote device to a communications operator for determining a download technology capability of the remote device by the communications operator as recited in claim 1.

Citrano et al. does not disclose or suggest automatically selecting one of the download technologies from the plurality of download technologies by the communications operator to download information to the remote device based upon the download technology capability of the remote device as recited in claim 1.

The features of claim 1 are not disclosed or suggested in the cited art. Therefore, claim 1 is patentable and should be allowed.

Though the claims dependent upon claim 1 contain their own allowable subject matter, these claims should at least be

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allowable due to their dependence from allowable claim 1. However, to expedite prosecution at this time, no further comment will be made.

Independent claim 13 claims:

a wireless communications operator comprising a plurality of different download technologies for downloading information to a plurality of wireless receiving devices;

a system for determining download capabilities of each wireless receiving device; and

a system for selecting one of the download technologies of the wireless communications operator for each respective wireless receiving device based upon the individual download capabilities of the respective wireless receiving devices.

Citrano et al. does not disclose or suggest anything remotely similar to this, and it most certainly does not "anticipate" these claimed features. There is no disclosure or suggestion in Citrano et al. of different download technologies, much less a system for determining download capabilities of each wireless receiving device. Nor does Citrano et al. disclose or suggest a system for selecting one of the download technologies of the wireless communications operator for each respective wireless receiving device based upon the individual download capabilities of the respective wireless receiving devices. Any statement to the contrary is pure fiction. The features recited in claim 13 are not disclosed or suggested in

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Citrano et al. Therefore, claim 13 is patentable and should be allowed.

Though the claims dependent upon claim 13 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 13. However, to expedite prosecution at this time, no further comment will be made.

Independent claim 19 claims a system for transmitting, by a transceiver, download technology capabilities of a mobile communications device, stored in a memory, to a wireless communications operator. The examiner has admitted that Citrano et al. does not disclose or suggest storing download technology capabilities of a mobile communications device. The examiner then states that Coppinger et al. (paragraph 0008) discloses storing in a memory a record of device identification in association with other auxiliary/preferential information. However, neither Citrano et al. nor Coppinger et al., alone or together, disclose or suggest a system for transmitting, by a transceiver, download technology capabilities of a mobile communications device, stored in a memory, to a wireless communications operator. It appears that the examiner has been ignoring the phrase "download technology capabilities". A download technology capability is not merely any capability. It is a specific type of capability; a download technology capability such as BREW or SMS for example. In other words, the ability to download information by technology such as BREW technology or SMS technology for example. Neither Citrano et al. nor Coppinger et al., alone or together, disclose or suggest a

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system for transmitting, by a transceiver, download technology capabilities of a mobile communications device (such as BREW technology capability or SMS technology capability for example), stored in a memory, to a wireless communications operator. Thus, the features of claim 19 are not disclosed or suggested in the cited art. Claim 19 is patentable and should be allowed.

Though the claims dependent upon claim 19 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 19. However, to expedite prosecution at this time, no further comment will be made.

Independent claim 25 claims a device comprising means for transmitting the download technology capabilities of a mobile communications device, stored in the memory, to a wireless communications operator. (see 35 U.S.C. 112, 6th paragraph). It is assumed that claim 25 was being rejected under 35 U.S.C. 103(a) as being unpatentable over Citrano et al. (WO 02/39596 A2) in view of Coppinger et al. (US 2001/0046862 A1), but the examiner should clarify in the next office action if necessary. Nowhere in Citrano et al. nor Coppinger et al. is there a disclosure or suggestion of means for transmitting the download technology capabilities of a mobile communications device, stored in the memory, to a wireless communications operator. This is most certainly not suggested by pages 2-4 of Citrano et al. in view of paragraph 0008 of Coppinger et al. The features of claim 25 are not disclosed or suggested in the cited art. Therefore, claim 25 is patentable and should be allowed.

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Though the claim dependent upon claim 25 contain its own allowable subject matter, this claim should at least be allowable due to its dependence from allowable claim 25. However, to expedite prosecution at this time, no further comment will be made.

Independent claim 27 claims a method comprising:

a step for providing a communications operator with a plurality of different download technologies;

a step for transmitting data from a remote device to the communications operator for determining a download technology capability of the remote device by the communications operator; and

a step for automatically selecting one of the download technologies from the plurality of download technologies by the communications operator to download information to the remote device based upon the download technology capability of the remote device.

Citrano et al. certainly does not "anticipate" the features of claim 27. Nowhere in Citrano et al. is there a disclosure of a step for providing a communications operator with a plurality of different download technologies, much less a step for transmitting data from a remote device to the communications operator for determining a download technology capability of the remote device by the communications operator. Nor is there any type of disclosure of a step for automatically selecting one of the download technologies from the plurality of download technologies by the communications

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operator to download information to the remote device based upon the download technology capability of the remote device. The features of claim 27 are not disclosed or suggested in the cited art. Therefore, claim 27 is patentable and should be allowed.

Independent claim 28 is a claim directed to a program storage device tangibly embodying a program of instructions executable for performing operations to select a download technology for downloading information to a remote device, the operations comprising:

receiving data from the remote device by a communications operator for determining a download technology capability of the remote device by the communications operator; and

automatically selecting a download technology from a plurality of download technologies by the communications operator to download information to the remote device based upon the download technology capability of the remote device.

No such program storage device or operations are "anticipated" by the description in Citrano et al. The features of claim 28 are patentable over Citrano et al. Thus, claim 28 should be allowed.

Favorable reconsideration and allowance is respectfully requested. Should any unresolved issue remain, the examiner is invited to call applicants' attorney at the telephone number indicated below.

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